

# INDEX

	Page
Opinions below.....	1
Jurisdiction.....	1
Questions presented.....	2
Statute involved.....	2
Statement.....	4
Argument.....	6
Conclusion.....	7

## CITATIONS

### Cases:

<i>Daniels v. Coe</i> , 116 F. (2d) 941.....	7
<i>Marine v. Wright</i> , 74 F. (2d) 996.....	5, 7
<i>United States v. Esnault-Pellerie</i> , 299 U. S. 201.....	6

### Statute:

Rev. Stat., Sec. 4915, as amended by the Act of March 2, 1927, sec. 11, 44 Stat. 1335, and the Act of March 2, 1929, sec. 2 (b), 45 Stat. 1475 (35 U. S. C. § 63).....	2
--	---

(I)

Page 2

4

5

6

7

8

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

26

27

28

29

30

31

32

33

34

35

36

37

38

39

40

# In the Supreme Court of the United States

OCTOBER TERM, 1941

---

No. 1034

RICHARD E. MARINE, PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

---

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED  
STATES COURT OF APPEALS FOR THE DISTRICT OF  
COLUMBIA

---

BRIEF FOR THE RESPONDENT IN OPPOSITION

---

## OPINIONS BELOW

The memorandum opinion of the United States District Court for the District of Columbia (R. 109) is reported in 32 F. Supp. 236. The *per curiam* opinion of the United States Court of Appeals for the District of Columbia (R. 186) is reported in 123 F. (2d) 340.

## JURISDICTION

The judgment of the United States Court of Appeals for the District of Columbia was entered on November 3, 1941 (R. 187). A petition for re-

hearing was denied on December 3, 1941 (R. 187). The time within which to file a petition for certiorari was extended by Chief Justice Stone to March 13, 1942 (R. 189). The petition for a writ of certiorari was filed on March 13, 1942. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

#### QUESTIONS PRESENTED

1. Whether the record contains evidence to support the conclusion of the District Court that petitioner's patent claims were disclosed in the prior art.

2. Whether an unsuccessful party in an interference proceeding may subsequently obtain a patent upon claims substantially the same as those involved in the interference proceeding.

#### STATUTE INVOLVED

Revised Statutes, sec. 4915, as amended by the Act of March 2, 1927, sec. 11, 44 Stat. 1335, and the Act of March 2, 1929, sec. 2 (b), 45 Stat. 1475 (35 U. S. C. § 63) provides:

Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the board of appeals to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section,

may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party, a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

## STATEMENT

The petitioner is the owner of Patent Application Serial No. 266,340, filed March 31, 1928, which includes claims 5, 57, and 58 (R. 2, 13). These claims relate to the construction of body posts at the ends of an automobile windshield with faces "in alignment" with the driver's lines of vision in order to give maximum body strength and minimum vision obstruction (R. 4, 13, 16). The prior art disclosed that obstruction to vision was virtually eliminated by a front corner post which did not exceed two and a half inches in width, the normal distance between a person's eyes (R. 20, 21). The reduction of the corner post to this width, however, had a weakening effect (R. 49-50). The petitioner's claimed invention consists in extending the construction of the post along the driver's lines of vision and thereby increasing its strength without increasing the obstruction to vision (R. 3). Claims 5 and 57 relate to posts having one face in alignment with the driver's line of vision; claim 58 relates to a post having two faces in alignment with the driver's lines of vision (R. 4, 13). The latter claim was sustained in the District Court, and is not now in issue (R. 110-111, 113). Only claims 5 and 57 are involved here (Pet. p. 2).

Petitioner's application was involved in interference with an application of Wright, which has now matured into patent No. 2,061,788, on a count which described a post having a front face

“substantially in alignment” with the driver’s forward line of vision, and a windshield end frame member substantially in alignment with the front face (R. 2-3, 6, 14). Petitioner was notified in the declaration of the interference that his claim 5 disclosing a body face “in alignment” with the driver’s line of vision would be held subject to rejection as unpatentable in the event priority was awarded to an adverse applicant (R. 136). The Patent Office tribunals awarded priority to Wright (R. 151-156, 166-170) and the decision was affirmed by the United States Court of Customs and Patent Appeals. *Marine v. Wright*, 74 F. (2d) 996. Thereafter, the claims here involved were rejected by the examiner in view of the prior determination in the interference proceeding, and on the ground that the claims were anticipated by Wright’s disclosure (R. 134-137). This rejection was affirmed by the Board of Appeals of the Patent Office (R. 4-5, 14), whereupon the petitioner filed an action under section 4915 of the Revised Statutes in the District Court of the United States for the District of Columbia (R. 1-13).

The District Court rejected the claims on the grounds that they were substantially the same as those adjudged adversely to the petitioner in the prior interference, and that the evidence in the present proceeding, independently considered, required the conclusion that the claims were disclosed by the prior art (R. 109-113). On appeal by peti-

tioner to the Court of Appeals for the District of Columbia, the judgment was affirmed upon the findings of fact, conclusions of law, and opinion of the District Court (R. 186).

#### ARGUMENT

The decision of the court below is clearly correct. The question of invention is one of fact. *United States v. Esnault-Pelterie*, 299 U. S. 201, 205. The Patent Office and the District Court have both found that the substance of petitioner's claims were disclosed in the prior art (R. 4-5, 14, 109-113), and the findings are supported by substantial evidence. Wright's patent application described the front face of his post as "extending rearwardly at an angle in line with the normal line of vision of the automobile driver" (R. 174, 180), a disclosure which plainly anticipated the petitioner's claims and which, by its terms, negatives the suggestion (Pet. 9-10) that Wright's illustration of "substantial alignment" in the accompanying drawing was merely accidental. The suggestion (Pet. 12-14) that the claim of "alignment" described in petitioner's application is narrower than and not included within the prior disclosure of "substantial alignment" is without merit. The principle was disclosed and the difference, if any, in the degree of alignment embodied in petitioner's claims involves no element of novelty or invention, particu-



larly since, as petitioner testified (R. 51), "in none of these cases can you fix an absolute position of the driver's eye."

Moreover, petitioner's claims are foreclosed by the adverse decision in the interference proceeding by "an adaptation for patent cases of the basic doctrine of *res judicata*, estoppel by judgment." *Daniels v. Coe*, 116 F. (2d) 941, 943 (App. D. C.). Virtually the same arguments presented by petitioner in his application for a writ and in the court below were made and rejected in the prior interference proceeding. *Marine v. Wright, supra*. The distinction between the present claim of "alignment" and that of "substantial alignment" involved in the interference is immaterial. Moreover, the decision in interference is conclusive on all claims that could have been presented, a rule which is peculiarly applicable here in view of the notice to petitioner in the declaration of interference that the claim of "alignment" in claim 5 would be held subject to rejection in the event of an adverse decision in the interference proceeding. Cf. *Daniels v. Coe, supra*, at p. 943.

#### CONCLUSION

The decision of the court below rests upon findings of fact which are supported by the evidence. There is no conflict of decisions, and no question of general importance. It is therefore respectfully

submitted that the petition for a writ of certiorari should be denied.

CHARLES FAHY,  
*Solicitor General.*

FRANCIS M. SHEA,  
*Assistant Attorney General.*

MELVIN H. SIEGEL,  
MORTON LIFTIN,  
*Attorneys.*

W. W. COCHRAN,  
*Solicitor for the Patent Office.*

